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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/528,980	07/12/2005	Antonella Giannini	20022/41076	6395

4743 7590 12/05/2007  
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EXAMINER
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PICKETT, JOHN G

ART UNIT	PAPER NUMBER
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3728

MAIL DATE	DELIVERY MODE
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12/05/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/528,980

Applicant(s)

GIANNINI ET AL.

Examiner

Greg Pickett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 23-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 March 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 11/14/05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This Office Action acknowledges the applicant's Preliminary Amendment filed 23 March 2005; the amendment cancels claims 1-22 and presents claims 23-44 as "New". It is noted that the amendment is not in compliance with 37 CFR 1.121 since the original claim set presents claims 1-30. Accordingly claims 23-30 should have been listed as "Currently Amended". As the original claims and the preliminary amendment were filed concurrently, it is presumed that the preliminary amendment is the claim set of record. Claims 23-44 will be examined on their merits, claims 1-22 have been canceled.

### ***Oath/Declaration***

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:  
It does not state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56.

Applicant's declaration is limited to only 37 CFR 1.56(a); this is insufficient acknowledgement. It is recommended that the applicant use form PTO/SB/104, which is available on the web at <http://www.uspto.gov/web/forms/index.html#patent>.

### ***Claim Objections***

3. Claims 35 and 36 are objected to because of the following informalities:

In claim 35, applicant uses the same item number (15') to describe both the first and fifth panels; the same item number (17') to describe the second and fourth panels; and the same item number (18') to describe the first and second wings.

In claim 36, applicant uses the same item number (10') to describe both the first and fifth panels, and the same item number (9') to describe both the second and fourth panels.

Appropriate correction is required.

### ***Drawings***

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the feature that each wing (7', 8') of third panel (11') having two wings (9''') at opposite ends of the wings (7', 8'), as recited in claim 36, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. Both Figures 5 and 8 of the original disclosure show only a single wing (9''') at a single end of the wings (7', 8') of third panel (11'). Further, the beveled edges of claim 39 must be shown or the feature(s) canceled from the claim(s). Still further, the obtuse, dihedral angles, as claimed in claims 40 and 41, must be shown or the feature(s) canceled from the claim(s). Moreover, the stop means of claims 43 and 44 must be shown or the feature(s) canceled from the claim(s).

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate

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prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action.

The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 23, 31, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Agnes (US 6,435,342) in view of Evers et al (US 5,301,805).

Claim 23: Agnes discloses a rigid package 1 for tobacco articles comprising a first container 2 with an open end and arranged as claimed, a lid 3 connected to the container 2 along hinge 10 as claimed, and a second container 13 for housing the tobacco articles house within the first container 12. Agnes teaches the inner container as firmly secured within the outer container (Col. 3, lines 19-12) and lacks the express disclosure of the second container housed in sliding manner inside the first container.

Agnes teaches that the second container may be formed separately and subsequently inserted into the first container (see for example Col. 3, lines 55-56).

Evers teaches that it was known and desirable in the art to reuse an external hard package with multiple inner packs. Evers teaches sliding receipt of an internal pack within a reusable, rigid external package for the purpose of protecting the internal pack without incurring the cost of supplying a hard package for each pack (see for example the Abstract and Col. 1, lines 25-33).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the inner liner of Agnes as removable/slidable in order to enable multiple, separately formed inner containers 13 to be used within a single outer container 2, as suggested by Evers. Although Agnes provides an intent that the inner pack 13 be either adhered to, or tightly fit within the external package (Col. 3, lines 19-23), there appears to be no specified purpose or reason for the adherence and one of ordinary skill in the art would recognize that the package would perform equally well with a removable/slidable inner pack. Therefore one of ordinary skill in the art would reasonable expect success in applying the removable feature taught by Evers to the package of Agnes.

Claim 31: Agnes anticipates a second container (see Figure 13) with top and bottom end walls 106/107, front and rear major lateral walls 101/102, minor lateral walls 103/104, and open portion 110 arranged as claimed.

Claim 36: Agnes discloses first container 2 formed from a blank (see Figure 4) of longitudinal and transverse crease lines 30 and comprising a first panel 33, second panel 21, third panel 11, fourth panel 32, and fifth panel 36 with wings 4/23/39/37 and secondary wings 38/39/40/41 located at each end of wings 37/39 of third panel 11.

6. Claims 24, 25, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Agnes-Evers as applied to claim 23 above, and further in view of Focke et al (US 2002/0179464).

Agnes-Evers, as applied to claim 23 above, discloses the claimed invention except for the claimed gap between the lid and front wall of the first/outer container.

Focke '464 teaches a gap between the lid and front wall of the first/outer container (see Figures 1 and 4) that partially exposes the inner liner 35, and is for the purpose of ease of opening (see for example paragraph [0007]). Focke '464 teaches the gap with a constant distance (claim 25) between straight lines (claim 28). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the package of Agnes-Evers with a gap between the lid and front wall of the first/outer container as taught by Focke '464 in order to make it easier to open the package.

7. Claims 24, 26, 27, 29, 30, 32-35, and 37-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Agnes-Evers as applied to claims 23 and 31 above, and further in view of Focke et al (US 6,360,943).

Claims 24, 26, 27, 29, and 30: Agnes-Evers, as applied to claim 23 above, discloses the claimed invention except for the claimed gap between the lid and front wall of the first/outer container.

Focke '943 teaches a gap between the lid and front wall of the first/outer container (see Figures 1, 5, 9, and 13) that partially exposes the inner liner 27, and is for the purpose of ease of handling (see for example Col. 1, lines 21-24). Focke '943 teaches the gap with a variable distance (see Figure 1, applies to claim 26) between lines that contact at the side edges of the package (see Figure 1, applies to claim 27),



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and lines that are bent or curved (see Figure 1, applies to claims 29 and 30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the package of Agnes-Evers with a gap between the lid and front wall of the first/outer container as taught by Focke '943 in order to improve handling of the package and lid.

Claims 32, 37, and 38: Agnes-Evers, as applied to claim 31 above, discloses the claimed invention except for the rounded edges. Focke '943 teaches rounding of edges 59 (see Figures 11 and 12). It would have been obvious to one of ordinary skill in the art at the time the invention was made to round the edges of the inner pack of Agnes in order to either ease insertion into the outer container or limit the sharp edges of the pack.

Claim 33: Agnes discloses squared edges (see Figure 3).

Claim 34: Packages of tobacco products are often worn within a clothing pocket. Focke '943 teaches rounding of edges 59 (see Figures 11 and 12). It would have been obvious to one of ordinary skill in the art at the time the invention was made to round the edges of the outer container in order to reduce wear on clothing.

Claims 35, 40, and 41: Agnes, in Figure 13, discloses a second container with a first panel 104, second panel 101, third panel 103, fourth panel 102, and fifth panel 105 separated by transverse crease lines and first and second wings 106 and 107 separated by longitudinal crease lines. Agnes merely lacks the group of longitudinal crease lines comprising a plurality of crease lines. Focke '943 teaches a plurality of crease lines for forming rounded edges 59 (see Figures 11 and 12). It would have been

obvious to one of ordinary skill in the art at the time the invention was made to provide the second container with a plurality of crease lines in order to round the edges and either ease insertion into the outer package or eliminate sharp edges. Such plurality of crease lines form a plurality of obtuse, dihedral angles.

Claim 39: Official Notice is taken that beveling of edges was a known equivalent of rounded edges for the elimination of sharp edges. Therefore, because these two edges were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute the beveled edges for the rounded edges; such a substitution would predictably function to eliminate the sharp edges. An express suggestion to substitute one equivalent component or process for another is not necessary to render such substitution obvious. *In re Fout*, 675 F.2d 297, 213 USPQ 532 (CCPA 1982). Applicant, of course, has the right to challenge this Official Notice in response to this decision and demand production of evidence in support thereof, provided such challenge is accompanied by adequate information or argument that, on its face, creates a reasonable doubt regarding the circumstances justifying the Official Notice. See *In Re Boon*, 439 F.2d 724, 169 USPQ 231, 234 (CCPA 1971). To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b). See also *Chevenard*, 139 F.2d at 713, 60 USPQ at 241.

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8. Claims 42-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Agnes-Evers, as applied to claim 23 above, and further in view of Phillips (GB 2115386).

Claim 42: Agnes-Evers, as applied to claim 23 above, discloses the claimed invention except for the through-hole. Phillips teaches a through-hole 15 for assisting in sliding an internal container out of an external package, and for said purpose, it would have been obvious to one of ordinary skill in the art to provide the package of Agnes-Evers with a through-hole.

Use of the terminology "stop means", in claims 43 and 44, does not appear to invoke the provisions of 35 USC 112, 6<sup>th</sup> paragraph. With respect to claims 43 and 44, Agnes-Evers, as applied to claim 23 above, discloses the claimed invention except for the stop means. Phillips teaches a stop means 12/16 for limiting the removal of the internal container, and for said purpose, it would have been obvious to one of ordinary skill in the art to provide the package of Agnes-Evers with a stop means as claimed.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greg Pickett whose telephone number is 571-272-4560. The examiner can normally be reached on Mon-Fri, 11:30 AM - 8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Greg Pickett/  
Examiner  
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